

REMARKS

By this amendment, claims 1, 5 and 7 have been amended. Claims 1-8 and 10 remain in the application. Support for the amendments can be found the specification and drawings. No new matter has been added. This application has been carefully considered in connection with the Examiner's Action. Reconsideration, and allowance of the application, as amended, is requested.

Rejection under 35 U.S.C. §103

Claim 1:

Claim 1 recites an audio-video program recommendation system for listing program material in accordance with a user's preferences, said system comprising:

- a microprocessor for recognizing and processing identifying signals for program items;

- an electronic storage device coupled to said microprocessor for storing look-up lists of program items and signals associated therewith, said look-up lists including a list of previously viewed program items;

- a recommendation algorithm (a) incorporated into said microprocessor for choosing and listing recommended program items for current viewing on a display based upon (a)(i) the nature and frequency of previous program item selections and (a)(ii) previously viewed program items that are recorded in said look-up lists in said electronic memory device, wherein the recommendation algorithm excludes the choosing and listing of all previously viewed items from the look-up list in the listing of recommended items for current viewing on the display;

- instructional material (b) presented on said display (b)(i) for concurrently selectively identifying said selected ones of said recommended program items as having been previously viewed outside the purview of the recommendation system to avoid all future recommendation listings and (b)(ii) for selectively

identifying a selected one of said recommended program items for current viewing; and,

a user-operable input signal device coupled to said microprocessor, enabling a user to selectively identify selected ones of said recommended program items on said display as having been previously viewed outside the purview of the recommendation system, such that said microprocessor (c) then (c)(i) removes said selected ones of said recommended program items identified as having been previously viewed from said listed recommended program items for current viewing on said display, (c)(ii) displays a revised listing of recommended program items for current viewing, and (c)(iii) adds said selected ones of said recommended program items identified as having been previously viewed to said look-up lists in said memory device without actually selecting the corresponding program for viewing.

Support for the amendments to claim 1 (as well as for claim 5 and 7) can be found in the specification at least on page 2, lines 14-15; page 3, lines 7-8, 16-17, and 21-22; page 4, lines 1-2; page 7, lines 14-16; page 9, lines 7-9 and 18-22; and page 10, lines 1-2.

Claims 1, 5, 8 and 10 were rejected under 35 U.S.C. §103(a) as being unpatentable over **Finseth** et al (US 2005/0028207) in view of **Usui** et al (US 6,075,570) and **Hassell** et al (US 2007/0033615).

With respect to claim 1, as amended herein, Applicant respectfully traverses this rejection on the grounds that these references are defective in establishing a prima facie case of obviousness.

As the PTO recognizes in MPEP § 2142:

... The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness...

It is submitted that, in the present case, the examiner has not factually supported a prima facie case of obviousness for the following reasons.

1. Even When Combined, the References Do Not Teach the Claimed Subject Matter

The **Finseth**, **Usui** and **Hassell** references cannot be applied to reject claim 1 under 35 U.S.C. §103 which provides that:

A patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains ... (Emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, since neither **Finseth**, **Usui** nor **Hassell** teaches a program recommendation system in which "look-up lists [include] a list of previously viewed program items; a recommendation algorithm ... chooses and lists ... *recommended program items* for current viewing on a display based upon (a)(i) the *nature and frequency* of previous program item selections and (a)(ii) *previously viewed program items* that are recorded in said look-up lists ... , wherein the recommendation algorithm excludes the choosing and listing of all previously viewed items ... in the listing of *recommended items* for current viewing on the display; ... instructional material (b) presented on said display (b)(i) for concurrently *selectively identifying* said selected ones of said recommended program items as having been previously viewed outside the purview of the recommendation system to avoid all future recommendation listings and (b)(ii) for *selectively identifying* a selected one of said recommended program items for current viewing; and ... input signal device ... enabling a user to *selectively identify selected ones* of said *recommended program items* on said display as having been previously viewed outside the purview of the recommendation system, *such that* said microprocessor (c) then (c)(i) *removes* said selected ones of said recommended

program items identified as having been previously viewed from said listed recommended program items for current viewing on said display, (c)(ii) *displays a revised* listing of recommended program items for current viewing, and (c)(iii) *adds* said selected ones of said recommended program items identified as having been previously viewed *to said look-up lists ... without* actually selecting the corresponding program for viewing" [emphasis added] as is now claimed in claim 1, it is impossible to render the subject matter of claim 1 as a whole obvious, and the explicit terms of the statute cannot be met.

Thus, for this reason, the examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

2. The Combination of References is Improper

Assuming, *arguendo*, that the above argument for non-obviousness does not apply (which is clearly not the case based on the above), there is still another compelling reason why the **Finseth**, **Usui** and **Hassell** references cannot be applied to reject claim 1 under 35 U.S.C. §103.

§ 2142 of the MPEP also provides:

...the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made.....The examiner must put aside knowledge of the applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole'.

Here, neither **Finseth**, **Usui** nor **Hassell** teaches, or even suggests, the desirability of the combination since none teaches the specific program recommendation system in which "look-up lists [include] a list of previously viewed program items; a recommendation algorithm ... chooses and lists ... *recommended program items* for current viewing on a display based upon (a)(i) the *nature and frequency* of previous program item selections and (a)(ii) *previously viewed program*

*items that are recorded in said look-up lists ... , wherein the recommendation algorithm excludes the choosing and listing of all previously viewed items ... in the listing of recommended items for current viewing on the display; ... instructional material (b) presented on said display (b)(i) for concurrently selectively identifying said selected ones of said recommended program items as having been previously viewed outside the purview of the recommendation system to avoid all future recommendation listings and (b)(ii) for selectively identifying a selected one of said recommended program items for current viewing; and ... input signal device ... enabling a user to selectively identify selected ones of said recommended program items on said display as having been previously viewed outside the purview of the recommendation system, *such that* said microprocessor (c) then (c)(i) *removes* said selected ones of said recommended program items identified as having been previously viewed from said listed recommended program items for current viewing on said display, (c)(ii) *displays a revised* listing of recommended program items for current viewing, and (c)(iii) *adds* said selected ones of said recommended program items identified as having been previously viewed *to said look-up lists ... without* actually selecting the corresponding program for viewing" as specified above and as claimed in claim 1.*

Thus, it is clear that neither reference provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103 rejection.

In this context, the MPEP further provides at § 2143.01:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. In the present case it is clear that the combination as suggested by the office action arises

solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in either reference for the combination as applied to claim 1. Therefore, for this reason, the examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

Accordingly, claim 1 is allowable and an early formal notice thereof is requested.

As presented herein, claim 5 has been amended in a similar manner with respect to the amendments to claim 1. Accordingly, the rejection of claim 5 is traversed for at least the same reasons presented herein above with respect to overcoming the rejection of claim 1. Thus claim 5 is also believed allowable and an early formal notice thereof is requested.

With respect to claims 8 and 10, the same depend from and further limit allowable independent claim 7 (as discussed herein below) and therefore are allowable as well. The 35 U.S.C. §103(a) rejection thereof has now been overcome. Withdrawal of the rejection is requested.

Claims 2, 3 and 6 were rejected under 35 U.S.C. §103(a) as being unpatentable over **Finseth** et al (US 2005/0028207) in view of **Usui** et al (US 6,075,570) and **Hassell** et al (US 2007/0033615) and further in view of **Percy** et al (US 4,646,145). Applicant respectfully traverses this rejection for at least the following reason. Claims 2 and 3 depend from and further limit allowable independent claim 1 and therefore are allowable as well. Claim 6 depends from and further limits allowable independent claim 5 and therefore is allowable as well. The 35 U.S.C. §103(a) rejection thereof has now been overcome. Withdrawal of the rejection is requested.

Claim 4 was rejected under 35 U.S.C. §103(a) as being unpatentable over **Finseth et al** (US 2005/0028207) in view of **Usui et al** (US 6,075,570), **Hassell et al** (US 2007/0033615), and **Percy et al** (US 4,646,145), and further in view of **Yamamoto** (US 2007/0006266). Applicant respectfully traverses this rejection for at least the following reason. Claim 4 depends from and further limits allowable independent claim 1 and therefore is allowable as well. The 35 U.S.C. §103(a) rejection thereof has now been overcome. Withdrawal of the rejection is requested.

Claim 7:

Claim 7 recites an improved method of recommending program listings in accordance with a user's selection preferences, said method comprising the steps of:

- accessing a first electronic list representing programs available for viewing at a given time;

- accessing a second electronic list (a) representing a compilation of programs (a)(i) previously selected for viewing and (a)(ii) previously viewed program items by an identified user of a system configured for implementing the recommendation method;

- comparing (b) said first electronic list with said second electronic list, to obtain a list of recommended program items based upon (b)(i) the nature of the previously selected programs and (b)(ii) previously viewed program items identified in said second electronic list, wherein the comparing to obtain the list of recommended program items excludes choosing and listing of all previously viewed items from the second electronic list in the list of recommended items for current viewing on a display device;

- displaying said list of recommended program items on the display device

for inspection by said user;

displaying a screen menu, together with said displaying of recommended program items, concurrently indicating (c) that (c)(i) a user can identify a recommended program item for current viewing, that (c)(ii) a user can identify a recommended program as being previously viewed outside the purview of the system configured for implementing the recommendation method by said user and that (c)(iii) a user can identify a recommended program as being unacceptable by said user;

selectively identifying and characterizing by a corresponding electronic signal, a program item on said list of recommended program items that was previously viewed outside the purview of the system or unacceptable by said user;

appending to said second electronic list, program items included in said list of recommended program items that are currently selectively identified and characterized as having been previously viewed by said identified user, without actually selecting the corresponding program for viewing; and,

removing said program items that are currently selectively identified and characterized as having been previously viewed by said identified user from said displayed list of recommended program items for current viewing and showing on said display a revised list of recommended program items without said program items selectively identified and characterized as having been previously viewed by said identified user.

Support for the amendments to claim 7 can be found in the specification at least on page 2, lines 14-15; page 3, lines 7-8, 16-17, and 21-22; page 4, lines 1-2; page 7, lines 14-16; page 9, lines 7-9 and 18-22; and page 10, lines 1-2.

Claim 7 was rejected under 35 U.S.C. §103(a) as being unpatentable over **Finseth et al** (US 2005/0028207) in view of **Usui et al** (US 6,075,570), **Hassell et al** (US 2007/0033615), and **Yamamoto** (US 2007/0006266).

Applicant respectfully traverses this rejection of amended claim 7, as presented herein, on the grounds that these references are defective in establishing a prima facie case of obviousness.

As the PTO recognizes in MPEP § 2142:

... The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness...

It is submitted that, in the present case, the examiner has not factually supported a prima facie case of obviousness for the following reasons.

3. Even When Combined, the References Do Not Teach the Claimed Subject Matter

The **Finseth**, **Usui**, **Hassel** and **Yamamoto** references cannot be applied to reject claim 7 under 35 U.S.C. §103 which provides that:

A patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains ... (Emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, since neither **Finseth**, **Usui**, **Hassel** nor **Yamamoto** teaches a method of recommending program listings which includes "accessing a second electronic list (a) representing a compilation of programs (a)(i) *previously selected for viewing and* (a)(ii) *previously viewed program items* by ...a system configured for implementing the recommendation method; *comparing* [the] *first* electronic list with said *second* electronic list, to obtain a *list of recommended program*

items based upon (b)(i) the nature of the previously selected programs and (b)(ii) previously viewed program items identified in said second electronic list, wherein the comparing ... to obtain the list of recommended program items excludes choosing and listing of all previously viewed items from the second electronic list in the list of recommended items for current viewing on a display device; ... displaying a screen menu, together with said displaying of recommended program items, concurrently indicating (c) that (c)(i) a user can identify a recommended program item for current viewing, that (c)(ii) a user can identify a recommended program as being previously viewed outside the purview of the system configured for implementing the recommendation method ... and that (c)(iii) a user can identify a recommended program as being unacceptable ... ; selectively identifying and characterizing ... a program item on said list of recommended program items that was previously viewed ... or unacceptable ...; appending to said second electronic list, program items included in said list of recommended program items that are ... currently selectively identified and characterized as having been previously viewed ... without actually selecting the corresponding program for viewing; and, removing said program items ... and showing ... a revised list of recommended program items without said program items selectively identified and characterized as having been previously viewed by said identified user" [emphasis added] as is now claimed in claim 7, it is impossible to render the subject matter of claim 7 as a whole obvious, and the explicit terms of the statute cannot be met.

Thus, for this reason, the examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

4. The Combination of References is Improper

Assuming, *arguendo*, that the above argument for non-obviousness does not apply (which is clearly not the case based on the above), there is still another compelling reason why the **Finseth, Usui, Hassel** and **Yamamoto** references cannot be applied to reject claim 7 under 35 U.S.C. §103.

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Here, neither **Finseth, Usui, Hassel** nor **Yamamoto** teaches, or even suggests, the desirability of the combination since none teaches the specific method of recommending program listings which includes "accessing a second electronic list (a) representing a compilation of programs (a)(i) *previously selected* for viewing and (a)(ii) *previously viewed program items* by ...a system configured for implementing the recommendation method; *comparing* [the] first electronic list with said *second* electronic list, to obtain a *list of recommended program items* based upon (b)(i) the *nature* of the previously selected programs and (b)(ii) *previously viewed program items* identified in said second electronic list, wherein the comparing ... to obtain the list of recommended program items excludes choosing and listing of all previously viewed items from the second electronic list in the list of recommended items for current viewing on a display device; ... displaying a screen menu, *together with* said displaying of *recommended program items*, concurrently indicating (c) that (c)(i) a user can *identify* a recommended program item *for current viewing*, that (c)(ii) a user can *identify* a recommended program *as being previously viewed outside the purview of the system configured for implementing the recommendation method* ... and that (c)(iii) a user can *identify* a recommended program *as being unacceptable* ... ; *selectively identifying and characterizing* ... a program item on said list of recommended program items that was *previously viewed* ... or *unacceptable* ...; *appending* to said second electronic list, *program items* included in said list of recommended program items that are ... *currently*

selectively identified and characterized as having been previously viewed ... without actually selecting the corresponding program for viewing; and, removing said program items ... and showing ... a revised list of recommended program items without said program items selectively identified and characterized as having been previously viewed by said identified user" [emphasis added] as specified above and as claimed in claim 7.

Thus, it is clear that neither reference provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103 rejection.

In this context, the MPEP further provides at § 2143.01:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. In the present case it is clear that the combination as suggested by the office action arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in either reference for the combination as applied to claim 7. Therefore, for this reason, the examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

Accordingly, claim 7 is allowable and an early formal notice thereof is requested.

Conclusion

Except as indicated herein, the claims were not amended in order to address issues of patentability and Applicants respectfully reserve all rights they may have under the Doctrine of Equivalents. Applicants furthermore reserve their right to reintroduce

subject matter deleted herein at a later time during the prosecution of this application or a continuation application.

It is clear from all of the foregoing that independent claims 1, 5 and 7 are in condition for allowance. Claims 2-4 depend from and further limit independent claim 1 and therefore are allowable as well. Claim 6 depends from and further limits independent claim 5 and therefore is allowable as well. Claims 8 and 10 depend from and further limit independent claim 7 and therefore are allowable as well.

The amendments herein are fully supported by the original specification and drawings; therefore, no new matter is introduced. An early formal notice of allowance of claims 1-8 and 10 is requested.

Respectfully submitted,

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